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LOTA PI LAW GROUP
350 CAMBRIDGE AVENUE SUITE 250
P O BOX 60850
PALO ALTO CA 94306-0850

EXAMINER

CHAKRABORTI, A

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/603,832

Applicant(s)

Kondejewski

Examiner

Arun Chakrabarti

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 2, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-802) 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152) 20) ☐ Other: _____

Art Unit: 1655

DETAILED ACTION

Specification

1. In response to the restriction requirement, the applicant has elected Group I, corresponding to claims 1-9. Claims 10-20 corresponding to Group II have been canceled without prejudice towards further prosecution.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected over the recitation of the phrase, "n is at least three". It is not clear if n is infinite or any number in between three and infinite. The metes and bounds of the claims are vague and indefinite.

Claim 1 is also rejected over the recitation of the structural limitation, "bcfg" with subscript "I". In absence of a definition of "I", it is not clear whether a specific number is claimed by the subscript "I" or a novel chemical structure is claimed. The metes and bounds of the claims are vague and indefinite.

Art Unit: 1655

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson (U.S. Patent 6,242,213 B1) (June 5, 2001).

Anderson teaches a coiled-coil polypeptide composition (Column 6, line 65 to column 7, line 1), comprising

a template of the form (abcdefg)n (Column 6, lines 18-24), where n is at least three, a and d are amino acids selected from the group consisting of leucine and isoleucine (Column 6, line 18 to column 7, line 1).

Anderson inherently teaches the sequence formed by the positions (bcdefg)n is a sequence of amino acids from a solvent-accessible region of an epitope from a selected protein (Column 6, lines 24-25). This rejection is based on the fact that segments of proteins containing polar amino acids are defined as solvent-accessible region. In this case, segments g and e containing oppositely charged residues will inherently provide the solvent-accessible region of an epitope from a selected protein.

Art Unit: 1655

Anderson teaches the composition where a is isoleucine and d is leucine (Column 6, line 65 to column 7, line 1).

Anderson teaches the composition wherein the coiled-coil polypeptide is comprised of two polypeptide chains arranged in a parallel configuration (Column 6, lines 14-29 and Column 6, line 65 to column 7, line 1).

Anderson teaches the composition wherein n is seven which is in between about 3 to about 20 (Column 6, lines 18-24).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1655

7. Claims 1-9 are rejected under 35 U.S.C. 103 (a) over Anderson (U.S. Patent 6,242,213 B1) (June 5, 2001) in view of Prusiner et al. (U.S. Patent 5,792,901) (August 11, 1998).

Anderson teaches the polypeptide composition of claims 1-5 as described above including the alpha-helical surface regions of cellular proteins (Column 6, lines 18-40).

Anderson does not teach the epitopes are exposed surface regions of infectious prion protein.

Prusiner et al. teach the epitopes are exposed surface regions of infectious prion protein (Abstract and Example 4).

Anderson does not teach the cellular prion protein is from hamster or human.

Prusiner et al. teaches the cellular prion protein is from human (Abstract and Example 4).

Anderson does not teach the epitope having SEQ ID NO:5.

Prusiner et al. teach the epitope having SEQ ID NO:5 (Figure 3).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to substitute and combine the epitopes present on the exposed surface regions of infectious prion protein consisting of SEQ ID NO:5 of Prusiner et al. in the polypeptide composition of Anderson, since Prusiner et al. state, "Yet another object of the invention is to provide for a method of testing samples for the presence of prions." (Column 6, lines 17-18). An ordinary practitioner would have been motivated to substitute and combine the epitopes present on the exposed surface regions of infectious prion protein of Prusiner et al. in the polypeptide composition of Anderson, in order to achieve the express advantages, as noted by

Art Unit: 1655

the polypeptide composition of Anderson, in order to achieve the express advantages, as noted by Prusiner et al., of an invention that provides for a method of testing samples for the presence of prions.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D., whose telephone number is (703) 306-5818. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the P.T.O. Fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 305-3014 or (703) 308-4242. Please note that the faxing of such papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Arun Chakrabarti

Patent Examiner

Art Unit 1655

July 12, 2001


JEFFREY FREDMAN
PRIMARY EXAMINER